

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEIJO PALVIINEN

Appeal No. 2005-1748
Application No. 09/446,508

ON BRIEF

Before KRASS, BARRETT, and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-22.

The invention is directed to a call forwarding technique in a mobile system that can be automatically routed specifically for each basic service.

Representative independent claim 1 is reproduced as follows:

1. A method for implementing call forwarding in a mobile system comprising at least one forwarding exchange for carrying out call forwarding via one of several alternative types of lines on the basis of subscriber data related to the call forwarding, each type of line having different qualities, and at least one subscriber database for storing the subscriber data related to the call forwarding, the method comprising:

receiving at the forwarding exchange a call set-up message addressed to a subscriber in the mobile system;

performing a subscriber data request to the subscriber database;

transmitting a response message from the subscriber database to the forwarding exchange, the message comprising data indicating the call forwarding, a forwarding number and the basic service code; and

implementing call routing to the forwarding number by selecting one of said alternative types of lines based on the basic service code.

The examiner relies on the following references:

Seraj	5,388,095	Feb. 07, 1995
Le Strat et al. (LeStrat)	6,134,220	Oct. 17, 2000
	(§102(e) date: Oct. 11, 1996)	
Joong et al. (Joong)	6,134,433	Oct. 17, 2000
		(filed Jun. 05, 1997)

Claims 1-22 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers Joong and LeStrat with regard to claims 1-14, 21, and 22, adding Seraj with regard to claims 15-20.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR §41.67(c)(1)(vii)].

With regard to independent claim 1, it is the examiner's position that Joong teaches the claimed subject matter (see page 4 of the answer) but for each type of line having different qualities. The examiner turns to LeStrat for a cellular system that handles voice calls and data calls and wherein the type of quality desired for a voice/data call can be selected, referring to column 4, lines 26-50, column 9, lines 16-56, and column 10, lines 21-58.

The examiner contends that it would have been obvious to modify Joong with the teachings of LeStrat "for the purpose of allowing a user more freedom in choosing the

desired quality of a call to possibly lower the amount of resources used in the call (col. 4, lines 41-50)” (answer-page 5).

Appellant argues that Joong “teaches away” from the instant claimed invention by failing to teach the implementation of call routing to a forwarding number by selecting, based on a basic service code, one of several alternative types of lines of different qualities, because Joong teaches that calls are forwarded to the line appropriate to the type of call based on a service code. Appellant argues that the “forwarding of a call to the particular line capable of handling the type of call is markedly different from the forwarding of a call to one among alternative lines of different qualities” (principal brief-page 9).

Appellant also argues that Joong fails to teach or suggest call forwarding by selecting a suitable line among several alternative lines of different quality **based on a service code**.

It is appellant’s position that LeStrat is of no help in providing for these deficiencies because LeStrat “teaches away” from the claimed invention, wherein “routing is performed to the forwarding number by selecting one of the alternative lines with different qualities based on the basic service code, not based on signal quality measurements as in LeStrat” (principal brief-page 10).

When the examiner responded that the preamble and the body of the claim do not tie in the selection of the types of lines in accordance with line quality, i.e., “the selection of the type of line discussed in the body of the claim is solely based on the basic service code and not the quality of the lines” (answer-page 12), and that claim 1 “does not require that the line selection be based on the quality of the line,” (answer-page 13), appellant responded with:

It is the quality which makes the line types different from each other and thus alternatives to each other. In such an environment one of ordinary skill in the art would easily understand that the claimed method step defining that “selecting one of said alternative types of lines based on the basic service code” should be interpreted such that the quality of the line type would be considered in the selection. One of ordinary skill in the art would also recognize, based on claim 1, and the underlying specification, that the quality is the selection criteria because the claim does not indicate any other criteria which would make the line types different from each other (reply brief-page 1).

We have reviewed the evidence before us, including the arguments of appellant and the examiner, and we conclude that the examiner has established a prima facie case of obviousness with regard to claim 1 and that that case has not been successfully rebutted by appellant.

While appellant desires us to interpret claim 1 such that the quality of the line type would be considered in the selection of one of the alternative types of lines, there

is nothing in the language of claim 1 which would provoke such an interpretation and we find no reason to read limitations from the specification into the claim. In re Winkhaus, 527 F.2d 637, 639, 188 USPQ 129, 130 (CCPA 1975). If appellant wished the claim to specify that the quality of the line type is a consideration in the selection of one of the alternative types of lines, it would have been a simple matter for the claim draftsman to have included such a limitation.

The preamble of the claim recites “each type of the line having different qualities” but when it comes to the recitation about selection of the line, the only criteria recited in the claim is one “based on the basic service code.” With regard to appellant’s argument that the quality of the line must be a selection criteria “because the claim does not indicate any other criteria which would make the line types different from each other” (reply brief-page 1), this is not a persuasive argument since the non-recitation of certain criteria may not serve as a basis for determining that that criteria (viz., quality) must be the selection criteria intended.

With regard to the implementation of call routing to a forwarding number, all that is required by instant claim 1 is “selecting one of said alternative types of lines based on the basic service code.” In the abstract alone, Joong recites that his system “allows the forwarding of calls of different types to appropriate devices for each type of call, as

identified by the call's service code." Clearly, Joong's "service code" is equivalent to appellant's "basic service code." At page 8, line 1, of the instant specification, appellant recites that "all service codes are called basic service codes."

Further, the forwarding of calls in Joong is based on this basic service code. Jong's "different types" of calls reads on the claimed "alternative types of lines" since there is no language in the claim which requires selection of lines of alternative qualities, based on the basic service code, which appellant now seeks to read into the claim. It is true that the claim mentions "each type of line having different qualities," but this is merely a recitation of one of the characteristics of the lines. It is not a recited criteria for selecting a particular line.

Moreover, even if we assumed, arguendo, which we don't, that the claim required the selection of a line from lines of varying qualities, since Joong forwards different types of calls to the "appropriate device for each type of call," and each device may be on a different line, it would appear that the lines in Joong are also of "different qualities" since no two lines are likely to offer "exactly" the same quality. It does not matter that the selected line may not be selected based on the basic service code because, again, claim 1 does not require the basic service code to indicate the "quality" of the line to be selected.

LeStrat is merely cumulative to the teaching that different lines may be of different "quality."

Thus, we will sustain the rejection of claim 1, and of its dependent claims 15 and 22, under 35 U.S.C. §103 over Joong and LeStrat.

We also will sustain the rejection of claims 2-4, 7, 8, 11, 12 and 16-19 under 35 U.S.C. §103 because appellant makes the same arguments presented with regard to claim 1. For the reasons supra, these arguments are not persuasive of patentability.

Appellant does present separate substantive arguments as to the merits of claims 5, 6, 9, 10, 13, 14, 20, and 21.

Specifically, with regard to claims 9 and 13, appellant argues that these claims add that the forwarding number is the number of a Voice Mail Service center having several lines, and that the exchange is arranged to transfer the call to the Voice Mail Service via a line selected for the transfer according to the basic service code. Appellant argues, indicating column 4, lines 30-44, of Joong, that there is no suggestion in Joong that the voice mail system (VMS) 13 has several lines, wherein a call is transferred to the VMS 13 via a line selected for the transfer according to the basic service code. Moreover, appellant point out, LeStrat contains no teaching or suggestion relating to voice mail centers.

We agree with the examiner that the VMS 13 of Joong “inherently” has several lines since the VMS services a plurality of customers with different telephone numbers. Moreover, since Joong forwards calls of different types to appropriate devices (e.g., VMS 13) for each type of call, as identified by the call’s service code, it would have been obvious to have as a forwarding number the number of a voice mail service center having several lines, and to transfer the call to the voice mail service via a line selected for the transfer according to a basic service code.

Thus, we will sustain the rejection of claims 9 and 13 under 35 U.S.C. §103.

With regard to claims 10 and 14, appellant notes that these claims add the limitation that the exchange is arranged to subject the forwarding number to a conversion selected according to the basic service code, and argues that neither Joong nor LeStrat suggests this feature. Appellant asserts that Joong merely discloses that the type of call may be identified directly from the ISDN User Part, User Service Information (USI) field which is mapped from the Bearer Capability Indicator (BCI) provided by the calling party, and that transfer numbers are administered via commands and procedures, citing column 6, lines 21-43, of Joong.

The limitation added by claims 10 and 14 is very broad, calling merely for subjecting a forwarding number to a “conversion” selected according to the basic service code. It recites nothing about the type of conversion nor what the forwarding

number is converted to. Accordingly, Joong's recitation, at column 6, lines 21-34, that a transfer number to forward a call is requested and that a Transfer to Number Request Invoke message may include the "service code parameter, appears to meet the claim limitation because the forwarded number is "converted" by including a basic service parameter thereinto, within the Transfer to Number Request Invoke message. Appellant admits that Joong discloses administering transfer numbers via commands and procedures, but fails to explain why this administration of transfer numbers may not be considered a "conversion" of the number to be transferred.

Accordingly, we will sustain the rejection of claims 10 and 14 under 35 U.S.C. §103.

With regard to claims 5, 6, 20, and 21, appellant contends that claim 5 contains a limitation directed to a home location register arranged to transmit a basic service code indicating the necessary properties of a line which should be selected for call routing from several alternative types of lines having different properties, and that Joong and LeStrat fail to teach such a feature. In fact, appellant contends, Joong teaches away from the claimed subject matter in focusing on an apparatus for routing a call of a particular type to a number capable of handling that call type, irrespective of line properties. Appellant argues that the "forwarding of a call to the particular line capable of handling the type of call is markedly different from the forwarding of a call to

one among alternative lines of different properties" (principal brief-page 15).

We will not sustain the rejection of claims 5, 6, 20, and 21 under 35 U.S.C. §103.

While independent claim 5 may appear rather broad in scope, it does set forth that the basic service code indicates the "necessary properties of the line" which should be selected. This makes it clear, unlike independent claim 1, for example, that the selection of one of the alternative lines is based on the quality, or property, of a particular line.

Joong recites nothing about making a selection of a line based on the property of the line, and LeStrat's teaching of choosing a transmission mode corresponding to a required level of quality does not provide for this deficiency of Joong, nor is there any apparent reason for combining the teachings of Joong and LeStrat in order to provide for a quality, or property, criterion when selecting a line in Joong.

The examiner's response is to merely rely on the arguments made anent claim 1. This is not persuasive because claim 1 does not require the basic service code to indicate the necessary properties of the line which should be selected.

Since the examiner has not presented a prima facie case of obviousness with regard to claim 5, and claims 6, 20, and 21 dependent therefrom, we will not sustain the rejection of these claims under 35 U.S.C. §103, based on the examiner's reasoning.

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We have sustained the rejection of claims 1-4, 7-19, and 22 under 35 U.S.C. §103 but we have not sustained the rejection of claims 5, 6, 20, and 21 under 35 U.S.C. §103.

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART

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